

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed February 26, 2007 (the “Office Action”). At the time of the Office Action, Claims 40-69 were pending in the Application, and stand rejected. Applicants respectfully request reconsideration and favorable action in this case.

The Office Action rejects Claims 40-69 under 35 U.S.C. 101 and contends that “the bodies of claims 40, 52, 64, 65 and 69 are nonstatutory because they are lacking of real world useful result”. *See Office Action*, page 2. Applicants respectfully disagree.

The patent laws define patentable subject matter as “any new and useful process, machine, manufacture or composition of matter, or any new and useful improvement thereto.” *See* 35 U.S.C. § 101. When an abstract idea is reduced to a practical application, the abstract idea no longer stands alone if the practical application of the abstract idea produces a useful, concrete, and tangible result. This then satisfies the requirements of 35 U.S.C. § 101. *See In re Alappat*, 33 F.3d 1526, 1544, 31 U.S.P.Q.2d 1545, 1557 (Fed. Cir. 1994); *see also State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368, 1373, 47 U.S.P.Q.2d 1596, 1601-02 (Fed. Cir. 1998). While an abstract idea by itself may not satisfy the requirements of 35 U.S.C. § 101, an abstract idea when practically applied to produce a useful, concrete, and tangible result satisfies 35 U.S.C. § 101. *See AT&T Corp. v. Excel Comm. Inc.*, 172 F.3d 1352, 1357, 50 U.S.P.Q. 1447, 1452 (Fed. Cir. 1999) (stating that as technology progressed, the CCPA overturned some of the earlier limiting principles regarding 35 U.S.C. § 101 and announced more expansive principles formulated with computer technology in mind); *see also In re Musgrave*, 431 F.2d 882, 167 U.S.P.Q. 280 (CCPA 1970) (cited by the Federal Circuit in *AT&T Corp.*, 172 F.3d at 1356). Thus, producing a useful, concrete, and tangible result is the key to patentability according to *State Street* and other applicable case law.

“Only when the claim is devoid of any limitation to a practical application in the technological arts should it be rejected under 35 U.S.C. 101.” M.P.E.P. § 2106. Indeed, a method or process remains statutory even if some or all of the steps therein can be performed in the human mind, with the aid of the human mind, or because it may be

necessary for one performing the method or process to think. *See In re Musgrave*, 431 F.2d at 893, 167 U.S.P.Q. at 289. As stated by the Federal Circuit in *State Street* and as explicitly confirmed in the M.P.E.P., “[T]ransformation of data, representing discrete dollar amounts, by a machine through a series of mathematical calculations into a final share price, constitutes a practical application of a mathematical algorithm, formula, or calculation, because it produces ‘a useful, concrete, and tangible result’ -- a final share price momentarily fixed for recording and reporting purposes and even accepted and relied upon by regulatory authorities and in subsequent trades.” *State Street*, 149 F.3d at 1373, 47 U.S.P.Q.2d at 1601-02; M.P.E.P. § 2106.

Furthermore, the M.P.E.P. states:

The applicant is in the best position to explain why an invention is believed useful. Office personnel should therefore *focus their efforts* on pointing out *statements made in the specification* that identify all practical applications for the invention. Office personnel should rely on such statements throughout the examination when assessing the invention for compliance with all statutory criteria. An applicant may assert more than one practical application, but only one is necessary to satisfy the utility requirement.

M.P.E.P. § 2106 (emphasis added).

Applicants' claims are not merely manipulations of abstract ideas. Instead, each of Applicants' claims recites a useful, concrete, and tangible result, which is all the law requires for a claim to be directed to statutory subject matter, and is therefore directed to patentable subject matter.

For example, Claim 40 includes the limitation “generating a dependency information tracking array”. This comprises a useful, concrete and tangible result. For at least these reasons, Applicants respectfully contend that Claim 40 is patentable under 35 U.S.C. 101.

Similar to Claim 40, each of Claims 52, 60, 64, 65 and 69 include similar limitations, generally related to generating a dependency information tracking array. Thus, for the same

reasons discussed above, Applicants respectfully contend that Claims 52, 60, 64, 65 and 69 are patentable under 35 U.S.C. 101.

Each of Claims 41-51, 53-59, 61-63 and 66-68 depend upon Claims 40, 52, 60 or 65 and are patentable for the same reasons discussed above with regard to their respective base claims.

Claims 40-42, 45, 52 and 60-69 are rejected under 35 U.S.C. 112 for allegedly failing to comply with the written description requirement. More specifically, the Office Action alleges that the limitation “indication from the database” does not support the description of the application’s specification.

Initially, Applicants note that the Examiner seems to be applying the wrong standard. As Applicants understand it, claims do not need to “support the description of the application’s specification”.

The specification of the instant application describes a method by which a database is queried to determine dependencies. See FIGURE 6. Certain claims of the instant application include a similar query, and also include “receiving an indication from the database of one or more dependencies”. Applicants respectfully contend that the limitations regarding receiving an indication from the database of one or more dependencies are fully supported by the specification as originally filed. For at least these reasons, Applicants respectfully contend that Claims 40-42, 45, 52 and 60-69 are patentable under 35 U.S.C. 112.

The Office Action rejects Claims 65-69 under 35 U.S.C. 112 and contends that the limitation “computer readable medium” in the first line of Claims 65-69 lacks antecedent basis. Applicants respectfully disagree.

Claim 65 is an independent claim. Therefore, it requires no antecedent basis for the limitation “computer readable medium”. Claims 66-69 depend from Claim 65 and receive antecedent basis from the term “a computer-readable medium” of Claim 65. For at least these reasons, Applicants respectfully contend that Claims 65-69 are patentable under 35 U.S.C. 112.

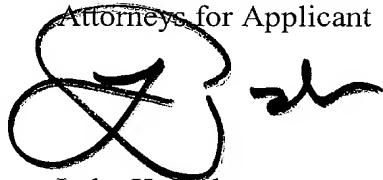
CONCLUSION

Applicants have made an earnest attempt to place this case in condition for allowance. For at least the foregoing reasons, Applicant respectfully requests full allowance of all pending Claims. If the Examiner feels that a telephone conference would advance prosecution of this Application in any manner, the undersigned attorney for Applicant stands ready to conduct such a conference at the convenience of the Examiner.

Applicants believe no fees are due. However, should there be a fee discrepancy, the Commissioner is hereby authorized to charge said fees or credit any overpayments to Deposit Account No. 02-0384 of BAKER BOTTS L.L.P.

Respectfully submitted,

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